

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 43

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

APR 25 2003

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDUARD HOFFMANN, WOLFGANG PREM,
and JOHANN WINTERHOLLER

Appeal No. 2001-0410
Application No. 08/856,944

ON BRIEF

Before THOMAS, GROSS, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

REMAND TO THE EXAMINER

We remand this application to the examiner for action in consideration of the issue addressed below.

REASON FOR REMAND

The Final Rejection (mailed Sep. 17, 1999; Paper No. 35) incorporates by reference an earlier final rejection (mailed Apr. 27, 1999; Paper No. 30) in which claims 1-17 are rejected under 35 U.S.C. § 103 over various combinations of references. The Examiner's Answer (mailed Sep. 8, 2000; Paper No. 40) asserts that the appeal involves claims 1-17, but disagrees with appellants' statement of the issues in appellants' Brief. The examiner contends instead that the issues are whether claim 1 is unpatentable over combinations of the prior art.

The Answer further asserts that "claims 1-17 stand or fall together." However, the only grounds of rejection set forth in the Answer are applied against instant claim 1. Grounds of rejection not argued in an Examiner's Answer are usually treated as having been dropped. See Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957) (rejection not referred to in the examiner's answer is assumed to have been withdrawn).

In view of the noted ambiguities in the Answer, we are remanding this application for a clear statement from the examiner with respect to standing rejections. Any rejections from the Final Rejection which are to be maintained on appeal must be repeated.¹ Any rejections not adhered to must be expressly withdrawn.

¹ An Examiner's Answer may incorporate by reference, to page and paragraph, rejections set forth in an earlier single Office action. See MPEP § 1208.

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This application, by virtue of its “special” status, requires an immediate action.

See MPEP § 708.01. It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

JAMES D. THOMAS
Administrative Patent Judge

Anita Pellman Gross
ANITA PELLMAN GROSS
Administrative Patent Judge


HOWARD B. BLANKENSHIP
Administrative Patent Judge

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